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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,818	06/28/2000	Jay S. Walker	00-001	5370
22927	7590	04/06/2005	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			FADOK, MARK A	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/605,818

Applicant(s)

WALKER ET AL.

Examiner

Mark Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 12-37, 43-50 and 56-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 38-42 and 51-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Election and RCE***

***Response to Amendment***

The examiner is in receipt of applicant's response to office action mailed 3/18/2004, which was received 8/23/2004. Acknowledgement is made to the amendment of independent claims 1,12,21,33,34,35,37,38,43,45,47,48,49,51,56,58,60, 61,62,64,69,71,73,74 and 75, which lead to the restriction requirement as is discussed below.

***Election***

The examiner is in receipt of applicant's response to election requirement mailed 11/15/2004, which was received 12/20/2004. Acknowledgement is made to the election of Group I, which includes claims 1-11, and 38-42 with traverse.

The applicant argues that the grouped inventions are not independent and distinct and that the examiner has not provided a prima facie case. The examiner disagrees and directs the applicant to the reasons stated by the examiner in the previous office action. Further, the applicant has failed to state that the plurality of inventions are obvious over each other.

Applicant argues combination and subcombination; however, the examiner has not distinguished the inventions as being subcombination/subcombination.

Applicant argues the use of process and apparatus was not sufficiently detailed and the 101 rejection has been overcome. The examiner disagrees and directs the

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applicant's attention to the reasons provided by the examiner and the following 101 rejection due to an ineffective amendment to overcome the previous 101 rejection.

Applicant argues that the examiner has not established an undue burden because the examiner has only used one subclass. The examiner notes that a search within 705/26 subclass is not limited to just that sub class, but requires a search of the all US patents, PG PUBs, IBM articles, Derwent and foreign patents found in the USPTO database. Also included, is a search of non-patent literature, which may include the Internet and databases such as Proquest and dialog. Please note that the restriction is done apriori, so the extent of the search is not necessarily known until each invention is searched.

The examiner agrees with the applicant's arguments concerning the addition of Group VII with Group I.

Based on the above remarks the restriction stands and an examination of claims 1-11,38-42 and 51-55 follows:

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are not within the technological arts.

The addition of "via a communications network" does not overcome the previous rejection. That is a communication network could encompass one person passing in information to another and so on and does not necessarily involve a computer.

*The claimed invention must utilize technology in a non-trivial manner (Ex parte Bowman, 61 USPQ2d, 1665,1671 (Bd. Pat. App. & Inter. 2001)).* Although Bowman is not precedential, it has been cited for its analysis.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-11,38-42 and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruss (an article from PTO-892) in view of Official Notice.**

In regards to claims 1-11,38-42 and 51-55, Bruss teaches arranging for a customer to redeem a product from a third party (page 2), receiving, via a communications network information relating to a redemption of the product and by the customer, that has occurred (page 2); Bruss does not specifically mention that there is a determining to accept an offer based on the received information, however it was notoriously well known in the art at the time of the invention to record information concerning a real estate sale in public records or the Multiple listing service (MLS),

Bruss would have been motivated to determine the acceptance of a subsequent offer, based on the most current information, because this would assure that the best price is being negotiated in favor of the person wishing to sell the property. The remaining features of the instant claims are all features, which are commonly found within a real estate transaction. Bruss would have been motivated to include these features, because theses are required to conclude a real estate transaction involving an assignable contract.

### ***Response to Amendment***

Applicant's arguments with respect to claims 1-11,38-42 and 51-55 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

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Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

***Alexandria, Va. 22313-1450***

or faxed to:

**(703) 872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703) 746-7206** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Mark Fadok

Patent Examiner